

11-22-04

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I hereby certify that this Petition from a Final Restriction Requirement, and a check for the petition fee in connection with Application No. 10/731,315 in the amount of \$130.00, are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR §1.10 on the date subscribed, in an envelope addressed to MAIL STOP PETITION, Director of Patents and Trademarks, P.O. Box 1450, Alexandria, Virginia 22313-1450, on the 19th day of NOVEMBER, 2004.

Ray R. Regan, Attorney for Applicant, Registration 36,899

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventors:	Kenneth L. Suazo, <i>et al.</i>
First Named Inventor:	Kenneth L. Suazo
Invention:	Apparatus for Transporting Water With Liner
Application No.	10/731,315
Attorney Docket Number:	2224.006DIV
Express Mail Label Number:	ER563728536US
Examiner:	Jong-Suk (James) Lee
Group Art Unit:	3673

**PETITION TO DIRECTOR
FROM FINAL RESTRICTION REQUIREMENT
UNDER 37 CFR §§1.143-1.144**

To: MAIL STOP PETITION
Director for Patents and Trademarks
P.O. Box 1450
Alexandria, Virginia
22313-1450

11/22/2004 HGBREM1 00000080 10731315

01 FC:1460

130.00 OP **STATUTORY BASES FOR PETITON**

This petition is from the Examiner's final restriction requirement entered in the office action mailed to Applicants on September 28, 2004.

In an excess of caution that the specific rules governing petitions from final restriction requirements do not supersede the general requirements of 37 CFR §1.181(f) in connection with the time within which a petition must be filed, this Petition is filed within two months of the

mailing date of the office action in which the restriction requirement was made final.

As required by 37 CFR §1.144, a Reply to the Office Action also is included with this paper.

The petition fee required by 37 CFR § 1.17(h) in the amount of \$130.00 is paid as follows: a check in the amount of the fee is enclosed; the Commissioner is authorized to charge any additional fees that may be required, or credit any overpayment, to Deposit Account Number 501565 for the Law Office of Ray R. Regan, P.A.; and if an additional extension of time is required, please consider this a petition therefore, and charge any additional fees that may be required to Deposit Account No. 501565.

A duplicate copy of this sheet is enclosed.

**APPLICANTS' ARGUMENTS SUPPORTING
REVIEW AND REVERSAL
OF FINAL RESTRICTION REQUIREMENT**

Status of Prosecution

Applicants filed the original divisional application on December 8, 2003. Claims 1-19 are pending. The Examiner mailed a first, non-substantive, non-final office action on June 18, 2004 directed solely to a restriction requirement. Applicants filed a Response to the restriction requirement on July 7, 2004 that included both a traversal of the restriction requirement, and a request for reconsideration. The Response also included an alternative election to prosecute claims 1-6, with claims 7-19 being withdrawn from examination.

The Examiner filed a first substantive office action (referred to in this document as "Office Action No. 2") on September 28, 2004 that made final the restriction requirement, and included substantive rejections of the claims. In response, Applicants have filed a Reply to Office Action No. 2, as well as this petition requesting reconsideration of the restriction requirement by the Director, and an order directed to the Examiner to examine not only claims 1-6, but also claims 7-19.

Examiner's Arguments

In Office Action No. 2 the Examiner responded to Applicants' traversal. See pages 2-3, Office Action No. 2. The Examiner advances the standard assertion from the MPEP that Applicants' arguments "are not found persuasive." The only support for that conclusion,

however, is the reiterated argument that the “structural elements are independently (sic, “independent”) and distinct.” That argument merely restates the question, and is not analytically responsive to the question. The question is whether the apparatus claimed in claims 1-19 are in fact independent and distinct. Applicants have shown, and will show again in this petition, that the apparatus are indeed not independent and distinct. Merely asserting the contrary is no argument at all; merely asserting the contrary is what the Director should find not persuasive. The Examiner, therefore, has not established a *prima facie* case for the restriction requirement.

On page 3, subparagraph ii) of Office Action No. 2, the Examiner asserts that the apparatus in question “could” be distinct. “Could” is not a sufficient test. That is particularly true when components are not distinct.

On page 3, subparagraph iii) of Office Action No. 2, the Examiner argues that although class 405 is sufficiently broad in scope to include all the claims of the application, nevertheless “the class and subclasses set forth in the restriction requirement are not necessarily the complete search for all inventions.” Applicants do not understand the Examiner’s contention. What is germane is that class 405 is sufficiently broad in scope to include all the claims of the application under consideration; the fact that class 405 does not encompass a complete search for all possible inventions other than those presented by Applicants is not the proper test for a restriction.

In a concluding comment on page 3, subparagraph iii) of Office Action No. 2, the Examiner concludes his arguments with the statement: “[A]n argument that the claims of the different inventions would be covered by the same search cannot be used as a criteria (sic, “criterion”) for a proper traversal of the restriction requirement because 35 U.S.C. §121 makes not (sic, “no”) provision for such provision for such grounds for traversal.” That argument misses the point entirely, and is patently incorrect in view of the teachings of the MPEP. See MPEP §802.01, which provides: “If the search and examination of the entire application can be made without serious burden, the examiner must examine [the application] on its merits, even though it includes claims to independent or distinct inventions.”

As Applicants have noted, 35 U.S.C. §121 also fails to define either “independent” or “distinct.” The Commissioner and the courts have had to go outside the statute to give some credibility and meaning to those words. The better view is, therefore, to consider any reason for

avoiding extended, expensive, unnecessary prosecution of interrelated components of the ditch liner system.

Indeed, what is needed is not rote application of a statute, but wise application of a rule of reason to Applicants' request; what is needed is not an observation that what is not included in a statute is therefore excluded.

Thus, MPEP §802.01 gallantly tries to "define" *independent* and *distinct*, but the Commissioner acknowledges "the terms 'independent' and 'distinct' are used in decisions with varying meanings...[and that] all decisions should be read carefully to determine the meaning intended." See MPEP §802.01. It follows, therefore, that other sources -- perhaps a rule of reason -- should also be considered "carefully to determine the meaning intended."

Applicants urge a rule of reason and a rule of reasonableness.

A proper reasonable rule of reason in this case would be: The ditch liner system for which a patent has issued transports water. It is useful to be able to receive and divert water from the ditch liner system from and to different directions and different water flow apparatus. Those diverters -- in the words of the claims, those inlet/outlet boxes, splitter sections, diversion sections, and adaptors -- are connectable to the main water transport system, namely the ditch liners.

The opposite of a rule of reason is the current restriction requirement that will cause a small entity to incur significant legal fees, significant Patent Office filing fees, and significant post-issuance maintenance fees unless, regardless of the facts, claims 1-19 are considered and examined together.

In Search of a Rule of Reason

As indicated, 35 U.S.C. §121 fails to provide an accepted definition of what is meant by *independent* and *distinct*. Thus, although MPEP §802.01 urges examiners "carefully to determine the meaning intended." See MPEP §802.01.

MPEP §800 *et seq.* further compounds analytical confusion. MPEP §803 incorrectly suggests that the test for restriction is whether an applicant's claims are directed to *independent* or *distinct* inventions, while 37 CFR 1.142 is addressed to *independent* and *distinct* inventions.

Focusing, therefore, on what are at best inadequate tests for a restriction requirement, Applicant submits that the claims under consideration ought not be restricted because they are neither independent nor distinct, and that the Director, therefore, should both withdraw the restriction requirement, and direct that claims 1-19 be examined together.

The Subject Matter is Dependent

MPEP §802.01 suggests that the word *independent* means, obviously, that something is not dependent, and that being not dependent “means that there is no disclosed relationship between the two or more subjects disclosed, [and that they are]...unconnected in design, operation, or effect.”

The application under examination, however, shows that the inlet/outlet box, splitter section, diversion section, and adaptor are in fact connected in design, operation, and effect not only among themselves, but with the subject matter of claims in the parent application that have since matured into U.S. Patent No. 6,692,186 B1, issued February 17, 2004. The parent application provides in part:

As used in this document, the terms “ditch liner section,” “liner section,” “liner,” and “section” mean, without limitation, the components described in this document that may be removably connected to form the apparatus, method and system for transporting water in accordance with the present invention. The terms therefore include a ditch liner section, an inlet/outlet box or channel, a diversion section, an adaptor, and a splitter section as described and claimed in this document.

See Application, page 5, lines 13-20.

While additional content of the parent application could be set forth to emphasize the point, including references to the drawing figures, the foregoing shows that the inlet/outlet box, splitter section, diversion section, and adaptor are in fact connected in design, operation, and effect, and are, therefore, dependent.

The Subject Matter is Distinct

MPEP §802.01 also purports to define *distinct*, but provides no case law reference to the definition. Rather, that section suggests that the term *distinct* means that although the subject matter is to be used in combination, the components are distinct if “capable of separate manufacture, use, or sale.” This assertion of a “definition” must be tempered, of course, by the limitation stated in that same section, namely that “the terms ‘independent’ and ‘distinct’ are

used in decisions with varying meanings...[and that] all decisions should be read carefully to determine the meaning intended.”

As a person skilled in the art would undoubtedly conclude from a review of the application being examined, the inlet/outlet box, splitter section, diversion section, and adaptor are not distinct inventions. The components are to be used with the ditch liner sections; they have no conceivable “use” separate and apart from the ditch liner section, or separate and apart from each other.

The term *distinct* certainly is not limited to the notion of “separate manufacture,” itself a term of questionable meaning. The notion of “separate manufacture” is but one of the three tests suggested. If by “separate manufacture” the definition presupposes that the subject matter under consideration could be manufactured “separately” from the liner to which they are attached, that fact does automatically or necessarily mean that the components of the ditch liner system are “distinct inventions.” Inversely, nothing in the nature of manufacturing is of record that would indicate that the inlet/outlet box, splitter section, diversion section, and adaptor could not be manufactured, for example, by rotational molding as components of a unitary body.

That leaves the question of “sale” standing alone in the clause setting forth the “definition” of *distinct*: are the components “capable of separate...sale....” Applicant acknowledges that almost any component of a mechanical system *may* be separately sold. But should that fact lead inexorably to a restriction in this case, given that Applicant has refuted the other arguments in connection with the words *independent* and *distinct*? Applicant thinks not, and accordingly asks the Director to reconsider the restriction requirement.

Classification System

Applicants have reviewed the current classification definitions. As the Examiner acknowledged, the class definition for class 405 is sufficiently broad in scope to include all the claims of the application in a single group for examination, given the context of the application as a whole. Further, the subclasses mentioned in Groups II-V could as well be sub-classified in a single Group, for example, under subclass 40.

The claims under Groups III and IV, having been placed under subclass 51 could, therefore, be grouped together. Applicant, therefore, submits for the Examiner’s consideration

that claims under consideration could be grouped under a single group for classification and restriction requirements.

Accordingly, Applicant requests that all claims under consideration be examined together.

Finally, Applicant also submits that there is no proof that the Examiner's arguments are not sufficient for a prima facie holding of restriction. Nothing of record, for example, supports the proposition that the apparatus under consideration is, for example, comparable to a rain gutter, or that the inventions in Groups II-V are separately usable, or have separate utility. Thus, while the alleged separate inventions are patentable over each other, there is no proof that the alleged separate inventions are capable of separate manufacture, use or sale.

Restriction Not Mandatory

Applicant also urges the Director to recognize that a restriction is not mandatory; it is permissive. "If two or more independent and distinct inventions are claimed in one application, the Director may require the applicant to be restricted to one of the inventions." See 35 U.S.C. §121.

Applicant has shown that the subject matter is clearly dependent. Applicant has shown that the subject matter is not for use except with the ditch liners. Applicant has shown that the subject matter is not both independent and distinct.

Given the classifications of the related subject matter, the search and examination of the entire application can be made without serious burden, the Examiner should examine the divisional application on its merits. See MPEP §802.01, which provides: "If the search and examination of the entire application can be made without serious burden, the examiner must examine [the application] on its merits, even though it includes claims to independent or distinct inventions."

The Examiner also should consider the obverse side of the "serious burden" issue: the serious financial burden imposed on Applicant to secure four separate patents in connection with a cluster of related, interdependent non-distinct apparatus functionally associated with the liners for which the inlet/outlet box, splitter section, diversion section, and adaptor were designed for use.

The claims under consideration do not present the more typical bases for restriction, where the two inventions are process and apparatus. Rather, the claims are different combinations that Applicant has disclosed as being "capable of use together." See MPEP §806.04(A). These facts also support reconsideration by the Examiner.

Conclusions

Therefore, Applicant submits that the claims subject to restriction in this case are neither independent nor distinct. Applicant respectfully requests reconsideration and withdrawal by the Examiner of the restriction requirement.

If the Examiner is unwilling to reconsider and withdraw the restriction requirement, Applicant is compelled by the Rules to elect to prosecute one grouping of claims, and Applicant therefore elects to prosecute the claims of Group I, namely claims 1-6, as categorized by the Examiner in the present office action.

WHEREFORE APPLICANT REQUESTS AN ORDER from the Director that:

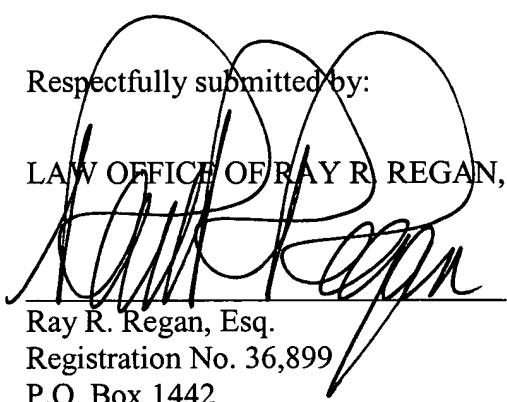
A. Reverses the Examiner's determination that the restriction requirement should be made final; and

B. Requires the Examiner to examine claims 1-19 collectively in a single examination.

Dated the 19th day of November, 2004

Respectfully submitted by:

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